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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,541	07/25/2003	Heinrich Gers-Barlag	Beiersdorf 700.1-HCL	3552

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EXAMINER	
LAMM, MARINA	
ART UNIT	**PAPER NUMBER**
1616	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/627,541	GERS-BARLAG ET AL.	
	Examiner	Art Unit	
	Marina Lamm	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3 and 6-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3 and 6-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/744,496.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/25/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 3 and 6-14 are pending in this application filed 7/25/03, which is a divisional of SN 09/744,496 filed 1/24/01, now US Patent No. 6,703,029, which is a 371 application of PCT/EP99/05241 filed 8/1/99, which claims priority to German application filed 8/1/98. Acknowledgment is made of the preliminary amendment filed 7/25/03. Claims 1, 3 and 6-10 have been amended. Claims 2, 4 and 5 have been cancelled. Claims 11-14 are new.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3 and 6-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,703,029 ('029). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim

is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 3 and 6-14 are generic to all that is recited in claims 1-11 of '029. That is, claims 1-11 of '029 fall entirely within the scope of claims 1, 3 and 6-14 of the instant invention, or, in other words, claims 1, 3 and 6-14 are anticipated by claims 1-11 of '029. Specifically, the instant claims recite a cosmetic or dermatological o/w or w/o emulsion, which is hydrocolloid-free and which comprises an oil phase, an aqueous phase, 1-30% by weight of at least one modified polysaccharide, which has amphiphilic properties and has no thickening properties, and at most 0.5% by weight of one or more emulsifier. The claims of '029 recite the same composition, which is emulsifier-free. Thus, the claims of '029 anticipate the instant claims.

3. Claims 1, 3 and 6-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,620,407 ('407). Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention overlaps with that previously claimed. Thus, the instant claims recite a cosmetic or dermatological o/w or w/o emulsion, which is hydrocolloid-free and which comprises an oil phase, an aqueous phase, 1-30% by weight of at least one modified polysaccharide,

which has amphiphilic properties and has no thickening properties, and at most 0.5% by weight of one or more emulsifier. The claims of '407 differ from the instant claims in that they do not recite the concentration of the modified amphiphilic polysaccharide. However, the portion of the specification in '407 that supports the recited modified amphiphilic polysaccharide, includes the concentration of the modified amphiphilic polysaccharide that would anticipate Claim 1 herein. See Examples. Claims 1, 3 and 6-14 cannot be considered patentably distinct over claims 1-11 of '407 when there is a specifically disclosed embodiment in '407 that supports claims of that patent and falls within the scope of Claim 1 herein because it would have been obvious to one having ordinary skill in the art to modify the claimed composition of '407 by selecting a specifically disclosed embodiment that supports that claim, i.e., the specific concentration of the modified amphiphilic polysaccharide. One having ordinary skill in the art would have been motivated to do this because that embodiment is disclosed as being a preferred embodiment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3, 6, 7 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Slavtcheff et al. (US 5,814,313).

Slavtcheff et al. teach thickened oil and water cosmetic emulsions containing 2-7% of the modified amphiphilic starch of the instant invention (i.e. Dry Flo®), which are emulsifier- and hydrocolloid-free. See col. 6, Examples 7-12. The compositions of Slavtcheff et al. may contain antioxidants (e.g. Vitamin E acetate) and preservatives (antimicrobials). See col. 5, lines 8-28; Examples 7-12. With respect to Claims 6 and 11, the average particle diameter of the starch derivative is inherent property of the compound.

Thus, Slavtcheff et al. teach each and every limitation of Claims 1, 3, 6, 7 and 9-11.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 8 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slavtcheff et al. (US 5,814,313) in view of either Cohen et al. (US 5,560,917) or Hansenne et al. (US 6,174,517).

Slavtcheff et al. applied as above. The reference does not teach the claimed pigments. However, Cohen et al. teach using surface-treated titanium dioxide and/or zinc oxide pigments as anti-aging components in cosmetic compositions. See col. 2, lines 40-41; col. 4, lines 25-65. Hansenne et al. teach using surface-treated titanium dioxide pigments of the instant claims, in cosmetic compositions, as sun-protective agents. See col. 1, lines 60-64; col. 5, lines 31-34, 59-62; col. 8, Table I. The surface-treated titanium dioxide of Hansenne et al. reduces color change of the composition, i.e. yellowing. See col. 8, line 63-67. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cosmetic compositions of Slavtcheff et al. such that to employ surface-modified titanium dioxide or zinc oxide pigments. One having ordinary skill in the art would have been motivated to do this to obtain anti-aging, sun-protective effect as suggested by either Cohen et al. or Hansenne et al.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,007,856 (see Example 1-3); US 5,462,759.

9. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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